

REMARKS***Reply to March 16, 2009 Advisory Action***

Examiner has advised that applicant's March 6, 2009 reply does not place the application in condition for allowance, for
5 two rejection reasons:

1) "The disclosure of the prior-filed application, Application No. 60/047,747, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claims 10, 59,

10 142,148,152,160 have the following claim limitation

'.....**without analyzing** said seven-digit telephone number in relation to telephone numbers previously dialed by the user.'

The limitation **without analyzing**, is not described in or supported by the disclosure of the prior-filed application No.

15 60/047,747."

2) "The sections of Application No. 601047747 that are referenced by applicant for support of the claims have issues that are not claimed. For example, page 3/49 in the PDF of US 60/047,747 (provided by applicant) discusses the use of an '8th
20 digits' and 'timing interval', which are not claimed. Thus, the subject matter of Applicant's independent claims is not fully disclosed in the priority application US 60/047,747."

We shall now examine each of these in turn.

Rejection reason 1)

MPEP §2163.07(a), titled "Inherent Function, Theory, or Advantage," states as follows:

By disclosing in a patent application a device that
5 inherently performs a function or has a property,
operates according to a theory or has an advantage, a
patent application necessarily discloses that
function, theory or advantage, even though it says
nothing explicit concerning it. The application may
10 later be amended to recite the function, theory or
advantage without introducing prohibited new matter.
In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971);
In re Smythe, 480 F. 2d 1376, 178 USPQ 279 (CCPA
1973). "To establish inherency, the extrinsic evidence
15 'must make clear that the missing descriptive matter
is necessarily present in the thing described in the
reference, and that it would be so recognized by
persons of ordinary skill. Inherency, however, may not
be established by probabilities or possibilities. The
20 mere fact that a certain thing may result from a given
set of circumstances is not sufficient.'" *In re*
Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51
(Fed. Cir. 1999) (citations omitted).

Examiner asserts that priority application US 60/047,747

does not disclose that portion of applicant's independent claim language which recites "without analyzing said seven-digit telephone number in relation to telephone numbers previously dialed by the user." In applicant's view, this claim recitation

5 is an inherent function of what is disclosed in US 60/047,747, that it is proper to have amended the claims to recite this function without introducing prohibited new matter, and that US 60/047,747 consequently does provide adequate support or enablement for the limitation "without analyzing said seven-

10 digit telephone number in relation to telephone numbers previously dialed by the user," in the manner provided by the first paragraph of 35 U.S.C. 112. Specifically:

US 60/047,747, in point 2) on page 3/49 of the PDF document provided to examiner, states: "If dialing starts with a 0 or a

15 1, all of the dialed digits will be passed directly through the system, since this is an indicator that the suffix system will not be used. If dialing starts with other than a 0 or 1: All digits are stored in the phone's special 'overlay system memory', and none are passed through until either: 1) 7 digits

20 have been entered + a timing interval has elapsed, in which case, the area code . . . is output by the phone, followed by the first 7 digits that were stored in the 'overlay system memory'. 2) 8 digits have been entered, in which case . . . [t]he proper area code is output, followed by the first 7 digits

that were stored in the 'overlay system memory'."

In the above, the use of the phrases involving "passing through" and "output by the phone" brings into the disclosure a standard of reference to what was known to persons of ordinary skill in the art, and, indeed, even to ordinary users of a telephone, at the time of applicant's invention. That is, this disclosure implicitly assumes, and properly so, that a person of ordinary skill knows what happens in a telephone system once a series of digits are "passed through" or "output by the phone" to the telephone company's signaling and switching system. Particularly, it is very well known to persons of ordinary skill and indeed ordinary telephone users that when an area code followed by 7 digits is output to the telephone company's signaling and switching system, the destination telephone represented by this string of digits will immediately be signaled forthwith without "analyzing said seven-digit telephone number in relation to telephone numbers previously dialed by the user" being required.

In particular, it is very well known and widely-understood, implicitly by any person using the telephone system, that when such a string of digits is "output" or "passed through" to the telephone company's signaling and switching system, the destination telephone represented by this string of digits will immediately be signaled forthwith "without analyzing said seven-

digit telephone number in relation to telephone numbers previously dialed by the user." As such, the fact that this function is done "without analyzing said seven-digit telephone number in relation to telephone numbers previously dialed by the user" is unquestionably inherent in the aforementioned passage from point 2) on page 3/49 of US 60/047,747, within the scope of MPEP §2163.07(a).

In other words, when one "outputs" or "passes through" to the telephone company's signaling and switching system, an area code followed by 7 digits, it is very widely understood that this inherently performs the function of signaling a call "without analyzing said seven-digit telephone number in relation to telephone numbers previously dialed by the user." In fact, this is so widely understood, that it would be superfluous and downright silly, to have to explain to a user that when they send a string comprising an area code plus seven digits to the phone company's signaling system, that the phone company will then place their call without having to make any reference whatsoever to any "telephone numbers previously dialed by the user." This is an implicitly understood aspect of dialing telephone numbers, which need not be explicitly stated to be inherently understood by individuals of ordinary skill in the art of using a telephone.

Referring again to MPEP §2163.07(a), the fact that a

telephone company's signaling and switching system, when an area code plus seven digits is provided thereto, does not need to make reference to "telephone numbers previously dialed by the user" in order to know how to properly route the call, is a
5 function which is necessarily present in how telephone signaling is conducted, and would be so recognized by persons of ordinary skill not only in the technical telephone arts, but merely in the art of dialing a telephone call, at present, and at the time of applicant's disclosure.

10 It stretches credulity to suggest, because applicant's disclosure "says nothing explicit concerning" the widely-known fact that passing or outputting to the phone company, an area code plus seven digits for signaling, allows a user's call to be placed "without analyzing said seven-digit telephone number in
15 relation to telephone numbers previously dialed by the user," that this fact is not inherently disclosed by applicant nonetheless, based on this very wide - substantially universal - knowledge of how telephone dialing works. Not only would this be recognized by persons of ordinary skill, it would be
20 recognized by virtually all persons, period. Thus, this is so basic a function that it need not be explicitly stated.

Finally, it is worth observing that the claim limitation "without analyzing said seven-digit telephone number in relation to telephone numbers previously dialed by the user" was only

introduced by applicant during prosecution to overcome
examiner's citation of prior art (Brendzel, US 5,859,901) which
was heavily centered upon the analysis of telephone numbers
previously dialed by the user. It is entirely appropriate for
5 applicant to amend his claims under MPEP §2163.07(a) to recite
that applicant's invention does NOT do what Brendzel does, when
this is fundamentally inherent in applicant's original
disclosure.

As such, the claim recitation of the function "without
10 analyzing said seven-digit telephone number in relation to
telephone numbers previously dialed by the user" is inherently
disclosed by applicant in US 60/047,747, and, under MPEP
§2163.07(a), this application therefore "may later be amended to
recite the function, theory or advantage without introducing
15 prohibited new matter." Examiner's rejection based on this
point is thereby overcome.

Rejection reason 2)

In this rejection, examiner states: "For example, page 3/49
in the PDF of US 60/047,747 (provided by applicant) discusses
20 the use of an '8th digits' and 'timing interval', which are not
claimed." We take the "8th digits" embodiment, and the "timing
interval" embodiment, separately, in turn.

The "8th digits" embodiment is the subject of independent
claims 108, 125, 146, 156, 158, and 164. While these claims do

not refer to these "8th digits" with the name "8th digits," these are nonetheless recited in the claims as "a plurality of area code selectors." This has clear and quite explicit support in US 60/047,747 on the top half of page 12/49, where it is

5 stated with original emphasis that ". . . the 8th digit is a suffix and acts as an overlay **selector**". Each area code within the overlay area will be assigned a unique identifier, which will then be used as the '8th digit suffix' or 'overlay selector' in dialing." While discussed here in the context of

10 overlays, this is clearly not limited to overlays, as is made pointedly emphasized on page 3/49 where it is stated that: "With these special phones or devices, the area codes that the 8th digit determines could be programmed by the user, i.e.: 0=818 1=626 2=213 3=805. The user can put in any coding they want,

15 and the suffixes don't necessarily have to refer to an actual overlay level. They might refer to any area code that the user feels would be convenient to be able to access with just a single digit at the end of a 7 digit phone number."

As such, the claims recitations for "a plurality of area

20 code selectors," and its association with the "8th digits" used to select area codes which are not necessarily limited to overlays, is in fact fully and properly disclosed by US 60/047,747. As such, "8th digits" are in fact claimed by the recitations for "a plurality of area code selectors," and are

properly supported under 35 USC § 112, first paragraph. Thus, examiner's rejection based on this point is thereby overcome.

The "timing delay" embodiment is pertinent to independent claims 10, 59, 142, 148, 152, and 160. Examiner is correct that the timing delay is not claimed. The question is whether the disclosure provides support for making a claim that does not include the timing delay. In applicant's view, the disclosure does provide such support.

Specifically, in Figure 4 and 4A on page 10/49 of US 60/047,747, it is stated that applicant's method "maintains the integrity of the original dialing area by: 1) Preserving established 7 digit dialing to all parent level numbers from any level within the overlay area." Further, in a box to the right of these figures, what is stated and illustrated is "7 Digit Dialing - Preserved, From 626 to 818 or Within 818: 123-4567." And, as noted earlier, it is pointedly emphasized on page 3/49 that this is clearly not limited to overlays.

At the time of the US 60/047,747 disclosure, in May 1997, "established 7 digit dialing" did NOT require a timing delay.

It would have been very clear to someone of ordinary skill in the art at the time that this disclosure was made by applicant, that "established 7 digit dialing" occurred by virtue of the telephone company's signaling and switching equipment: 1) examining the first three or four digits which it received; 2)

determining if the first digit was a "0" or "1" and / or if the first three or four digits contained a recognized area code; 3) if so, expecting to receive more than 7 digits (10 or 11 digits) before the necessary information was available to signal a call; and 4) if not, then simply waiting for a total of 7 digits to arrive, after which the call could be immediately signaled without the need to await a timing delay, or any other digits.

This is buttressed by the illustration to the upper right of Figures 4, where under "7 Digit Dialing - Preserved," there is illustrated the bare, established, 7-digit-only telephone number 123-4567, without an 8th digit, and without any mention of a timing delay.

There are other places in the US 60/047,747 disclosure where it is also made clear that the intent of applicant's invention is to preserve 7-digit dialing, where there is no reference made to requiring a timing delay. For example, not limitation: Page 11/49 first paragraph, lines 2 - 3: "The plan preserves established dialing patterns to existing numbers." Page 11/48 second bullet: ". . . the plan is non-disruptive to existing 7 digit and 1+10 digit dialing patterns . . ."

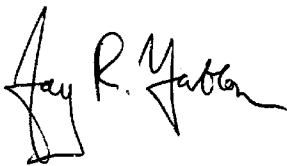
Clearly, by these illustrations in Figure 4, and by the reference in these Figures and elsewhere to Preserving established 7 digit dialing without disruption, without any timing delays and 8th digits being shown or being mentioned,

together with the fact that it was clearly understood by persons of ordinary skill that "established 7 digit dialing" in May 1997 referred to dialing 7 digits, period, without any timing delays or anything else, applicant in US 60/047,747 disclosed the
5 necessary § 112 support to present claims 10, 59, 142, 148, 152, and 160, without having to include a timing delay in these claims. Thus, examiner's rejection based on this point is thereby overcome.

As a result of the foregoing, all of the rejections
10 maintained in the advisory action have been overcome, and applicant respectfully requests a notice of allowance at this time.

Again, if this reply does not result in allowance of all claims, applicant's counsel hereby respectfully requests a
15 telephone interview with examiner Thjuan Knowlin Addy, following receipt of this reply, and prior to issuance of any further advisory action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay R. Yablon". The signature is stylized with a large, looped initial "J" and a cursive "Yablon".

Jay R. Yablon, Registration # 30604
910 Northumberland Drive
Schenectady, New York 12309-2814
Telephone / Fax: (518)377-6737
email: jyablon@nycap.rr.com